

## **REMARKS**

Entry of the foregoing and reexamination and reconsideration of the subject application, as amended, pursuant to and consistent with 37 C.F.R. § 1.112, are respectfully requested in light of the following remarks.

## **STATUS OF CLAIMS**

Claims 23-48 remain in this application. Claims 1-22 were previously cancelled. Claims 23 and 37 have been amended.

## **DISCUSSION OF AMENDMENTS**

Claim 23 has been amended to recite that component A, a system for generating a film-forming silicone network containing at least one polyorganosiloxane (POS) resin which crosslinks through polycondensation and which exhibits, per molecule, at least two different siloxyl units selected from those of types M, D, T, Q, one of the units being a T unit. The claim previously allowed one of the units to be a T unit or a Q unit. Claim 23 has also been amended to delete extraneous claim language and to modify the formatting of component B to improve the readability of the claim.

Claim 37 has been amended to clarify the recitation of the identities of the components when constituent B-2 is employed and to delete the designation B-2 after each of the components.

No new matter has been added by any of these amendments.

## **CLAIM FOR FOREIGN PRIORITY**

The Examiner has acknowledged the claim for foreign priority and the certified copy filed during the international phase, and this acknowledgment is appreciated. However, in the response to the previous Office Action, applicants noted that on January 25, 2007, a certified copy of the priority document, a verified English translation thereof and a STATEMENT IN COMPLIANCE WITH 37 C. F. R. § 1.57(a) offering remarks with respect to the certified copy of FR 04 00548 and its verified English translation. As noted in those papers, structural formulas which were present in the priority application were inadvertently omitted from the PCT

application, but were inserted in the claims presented in the Preliminary Amendment filed July 21, 2006. Applicants then obtained a certified copy of the French priority application and a verified English translation thereof, and filed these on January 25, 2007, together with the Statement in Compliance with 37 C.F.R. § 1.57(a) identifying where each omitted structure can be found in the certified copy and in the verified translation, thus complying with the requirements of 37 C.F.R. § 1.57(a) and MPEP 201.17. Acknowledgment is respectfully requested.

### CLAIM OBJECTIONS

Claims 37 and 38 have been objected to because it was questioned whether line 4 should read "constituent B-2".

Claim 37 has been amended to clarify the claim. Applicant believes that amended claim 37 is proper and requests the withdrawal of this objection.

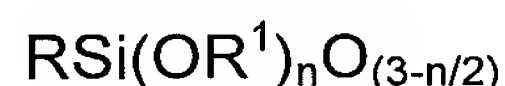
### CLAIM REJECTIONS - 35 USC § 102(b) or 35 USC § 103

1. Claims 23-35, 37, 38, 41 and 44-48 have been rejected under 35 USC § 102(b) as anticipated or, in the alternative, under 35 USC § 103(a) as obvious over Zotto (U.S. Patent No. 4,781,973 (hereafter Zotto)).

It is well established that in order to demonstrate anticipation over 35 U.S.C. § 102(b), each feature of the claim at issue must be found, either expressly described or under principles of inherency, in a single prior art reference. See, *Kalman v. Kimberly-Clark Corp.*, 218 USPQ 789 (Fed. Cir. 1983).

The claims of the instant applications require: A - a system for generating a film-forming silicone network containing at least one polyorganosiloxane (POS) resin which crosslinks through polycondensation and which exhibits, per molecule, at least two different siloxyl units selected from those of types M, D, T, Q, with one of the units being a T unit.

Zotto teaches a composition comprising an alkylalkoxypolysiloxane resin having greater than 50% by number units of the formula:



where  $n$  is 0, 1 or 2,  $R^1$  is a substituted or unsubstituted hydrocarbon radical of from 1 to 6 carbon atoms and  $R$  is a substituted or unsubstituted hydrocarbon radical of from 1 to 8 carbon atoms. However, Zotto does not teach a system for generating a film-forming silicone network containing at least one polyorganosiloxane (POS) resin which crosslinks through polycondensation and which exhibits, per molecule, at least two different siloxyl units selected from those of types M, D, T, Q, with one of the units being a T unit, as required by the instant claims. Zotto does not disclose each element required in the claims of the instant application. Therefore the instant claims are not anticipated by Zotto.

Applicant therefore requests the withdrawal of this rejection under 35 U.S.C. § 102(b).

To establish a *prima facie* case of obviousness, three basic criteria must be met. (MPEP 2143) First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations.

The teachings of Zotto are summarized in the Office Action.

To establish a *prima facie* case of obviousness, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. There is no suggestion or motivation in Zotto to modify Zotto to obtain the applicants' invention. Therefore, there is no suggestion or motivation, either in the cited reference itself or in the knowledge generally available to one of ordinary skill in the art, to modify the reference to obtain the invention of the instant application.

To establish a *prima facie* case of obviousness, there must be a reasonable expectation of success in obtaining the claimed method based on modification of the cited prior art. The Office Action has not provided any information on the expectation of success in obtaining the claimed method based on the modification of the cited prior art. One of ordinary skill in the art upon reading the cited prior art would not

believe that there was a reasonable expectation of success in obtaining the claimed method since the prior art is silent on the need for changing the claimed alkyloxypolysiloxane. In addition, such a person would recognize that there would have been some reason why Zotto did not disclose the use of other known families of alkyloxypolysiloxane, especially the claimed alkyloxypolysiloxane. Given the structural differences between the alkyloxypolysiloxane taught in Zotto and the alkyloxypolysiloxane required by the instant claims, and the lack of specific motivation to use the alkyloxypolysiloxane required by the instant claims, there cannot be a reasonable expectation of success in making required modification to Zotto. Therefore there is no reasonable expectation of success in producing the applicants' invention based on the teachings in the cited prior art.

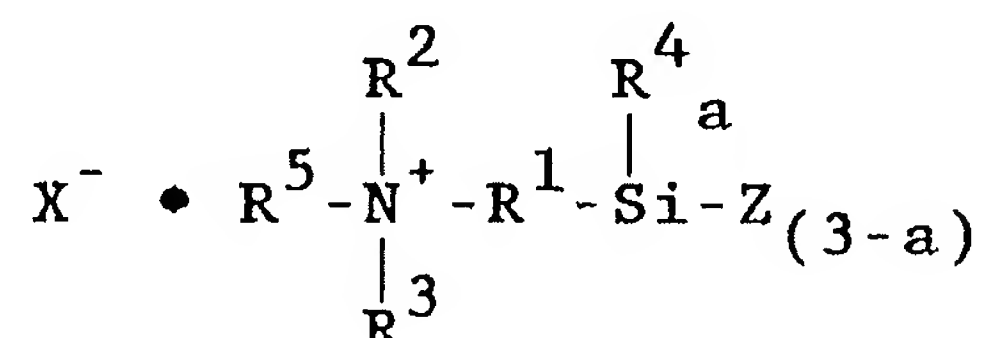
To establish a *prima facie* case of obviousness, the prior art reference (or references when combined) must teach or suggest all the claim limitations. Zotto does not teach a system for generating a film-forming silicone network containing at least one polyorganosiloxane (POS) resin which crosslinks through polycondensation and which exhibits, per molecule, at least two different siloxyl units selected from those of types M, D, T, Q, with one of the units being a T unit, as required by the instant claims. Therefore, the prior art reference does not teach or suggest all the claim limitations.

Therefore, the instant claims are not obvious over Zotto and Applicant respectfully requests withdrawal of the 103(a) rejection for these claims.

2. Claims 23-35, 37-39 and 44-48 have been rejected under 35 USC § 102(b) as anticipated or, in the alternative, under 35 USC § 103(a) as obvious over Ona (EP 506 113 (hereafter Ona)).

The claims of the instant applications require: A - a system for generating a film-forming silicone network containing at least one polyorganosiloxane (POS) resin which crosslinks through polycondensation and which exhibits, per molecule, at least two different siloxyl units selected from those of types M, D, T, Q, with one of the units being a T unit.

Ona teaches a composition comprising a polyorganosiloxane resin comprising  $\text{SiO}_{4/2}$  and  $\text{R}_3\text{SiO}_{1/2}$  units; a straight-chain diorganopolysiloxane; an organotitanate, organozirconate or organogermanate ester; and a silane of the formula:



or its partial hydrolysis condensate. However, Ona does not teach a system for generating a film-forming silicone network containing at least one polyorganosiloxane (POS) resin which crosslinks through polycondensation and which exhibits, per molecule, at least two different siloxyl units selected from those of types M, D, T, Q, with one of the units being a T unit, as required by the instant claims. Ona does not disclose each element required in the claims of the instant application. Therefore the instant claims are not anticipated by Ona.

Applicant therefore requests the withdrawal of this rejection under 35 U.S.C. § 102(b).

To establish a *prima facie* case of obviousness, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. There is no suggestion or motivation in Ona to modify Ona to obtain the applicants' invention. Therefore, there is no suggestion or motivation, either in the cited reference itself or in the knowledge generally available to one of ordinary skill in the art, to modify the reference to obtain the invention of the instant application.

To establish a *prima facie* case of obviousness, there must be a reasonable expectation of success in obtaining the claimed method based modification of the cited prior art. The Office Action has not provided any information on the expectation of success in obtaining the claimed method based on the modification of the cited prior art. One of ordinary skill in the art upon reading the cited prior art would not believe that there was a reasonable expectation of success in obtaining the claimed method since the prior art is silent on the need for changing the claimed



alkyloxypolysiloxane. In addition, such a person would recognize that there would have been some reason why Ona did not disclose the use of other known families of alkyloxypolysiloxane, especially the claimed alkyloxypolysiloxane. Given the structural differences between the alkyloxypolysiloxane taught in Ona and the alkyloxypolysiloxane required by the instant claims, and the lack of specific motivation to use the alkyloxypolysiloxane required by the instant claims, there cannot be a reasonable expectation of success in making required modification to Ona. Therefore there is no reasonable expectation of success in producing the applicants' invention based on the teachings in the cited prior art.

To establish a *prima facie* case of obviousness, the prior art reference (or references when combined) must teach or suggest all the claim limitations. Ona does not teach a system for generating a film-forming silicone network containing at least one polyorganosiloxane (POS) resin which crosslinks through polycondensation and which exhibits, per molecule, at least two different siloxyl units selected from those of types M, D, T, Q, with one of the units being a T unit, as required by the instant claims. Therefore, the prior art reference does not teach or suggest all the claim limitations.

Therefore, the instant claims are not obvious over Ona and Applicant respectfully requests withdrawal of the 103(a) rejection for these claims.

3. Claims 42 and 43 have been rejected under 35 USC § 103(a) as obvious over Zotto (U.S. Patent No. 4,781,973 (hereafter Zotto)).

Claims 42 and 43 depend from claim 23. It was shown above that claim 23 is not obvious over Zotto. Therefore claims 42 and 43, which depend from claim 23, cannot be obvious over Zotto.

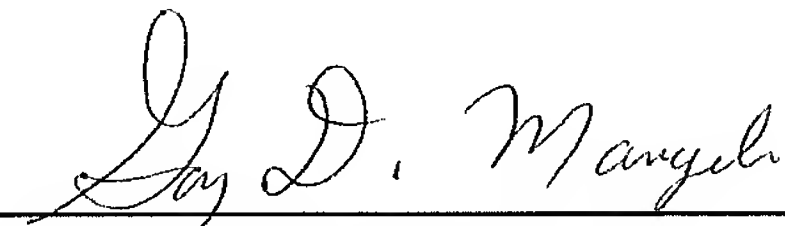
Therefore, the instant claims are not obvious over Zotto and Applicant respectfully requests withdrawal of the 103(a) rejection for these claims.

It is believed that all record rejections and objections have been overcome.  
Further, favorable action in the form of a Notice of Allowance is earnestly solicited.

Respectfully submitted,

BUCHANAN INGERSOLL & ROONEY PC

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